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PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/392,869	
	Filing Date	September 9, 1999	
	First Named Inventor	Steven P. NOLAN	
	Art Unit	1621	
	Examiner Name	P. Nazario-Gonzalez	
Total Number of Pages in This Submission	10	Attorney Docket Number	515622000100

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form + duplicate for fee processing - 2 pages <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1. Notice of Change of Status and Payment of Deficiency Owed - 7 pages 2. Return Receipt Postcard
Remarks		RECEIVED FEB 19 2004 OFFICE OF PETITIONS

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	MORRISON & FOERSTER LLP (Customer No. 25226) Philip D. Reilly - 41,415
Signature	
Date	February 9, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Date: February 9, 2004	Signature: (Aurelia A. Caparas)



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PTO/SB/17 (10-03)
Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003, Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 1,529.00

Complete if Known

Application Number	09/392,869
Filing Date	September 9, 1999
First Named Inventor	Steven P. NOLAN
Examiner Name	P. Nazario-Gonzalez
Art Unit	1621
Attorney Docket No.	515622000100

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit Account Number

03-1952

Deposit Account Name

Morrison & Foerster LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below		Fee Paid
137	-137** =	0	x	18	=	0
9	-9** =	0	x	86	=	0
Multiple Dependent				290	=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)				Payment of Deficiency Owed	1,529.00

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 1,529.00

SUBMITTED BY

Name (Print/Type)	Philip D. Reilly	Registration No. (Attorney/Agent)	41,415	Telephone	(650) 813-5980
Signature		Date	February 9, 2004		



#31

PATENT
Docket No. 515622000100

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: February 9, 2004 Signature: A. A. Caparas (Aurelia A. Caparas)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Steven P. NOLAN et al.

Serial No.: 09/392,869

Filing Date: September 9, 1999

For: CATALYST COMPLEX WITH
CARBENE LIGAND

Examiner: P. Nazario-Gonzales

Group Art Unit: 1621

02/19/2004 SLUANG1 00000001 061050 09392869

01 FC:1006	770.00 DA
02 FC:1201	86.00 DA
03 FC:1202	108.00 DA

**NOTICE OF CHANGE OF STATUS and
PAYMENT OF DEFICIENCY OWED
UNDER 37 C.F.R. §1.28(c)**

Mail Stop Issue Fee
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

02/17/2004 SLUANG1 00000001 031952 09392869

01 FC:1001	258.00 DA	512.00 DP
02 FC:1201	172.00 DA	
03 FC:1202	108.00 DA	

Dear Sir,

RECEIVED
FEB 19 2004
OFFICE OF PETITIONS

A good faith error appears to have been made regarding the entity status of the above-referenced application and some fee payments appear to have been made in error, claiming small entity discount. Applicants therefore request that the Office consider the following facts and explanations of the circumstances regarding the erroneous fee payments. As required under 37 C.F.R. §1.28(c), Applicants include in this submission an itemization of deficiencies owed from the previous erroneous payments and include the calculated deficiency payment.

02/13/2004 SLUANG1 00000031 031952 09392869

01 FC:1051	65.00 DA	65.00 DP
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pa-812919

02/17/2004 SLUANG2 00000001 031952 09392869

01 FC:1501	710.00 DA	620.00 DP
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Brief Chronology of Prosecution and Licensing of Instant Application Relevant to Entity Status Determination

The instant application claims priority to two provisional applications, filed September 10, 1998 and January 7, 1999, respectively. The first filed provisional application (Appln. No. 60/099,722, filed September 10, 1998) was filed claiming small entity status and the second filed provisional application (Appln. No. 60/115,358, filed January 7, 1999) was filed without a claim of small entity status. The instant application was filed on September 9, 1999 and was filed claiming small entity status.

All provisional and nonprovisional applications were filed with inventors Steven P. Nolan and Jinkun Huang, and the instant application was assigned to the University of New Orleans Foundation ("UNOF") by assignment dated September 8, 1999 and recorded at Reel/Frame number 010664/0389 on March 13, 2000.

During prosecution a Notice of Allowance was issued on September 30, 2000, the issue fee was paid (as a small entity) on December 19, 2000, a petition for withdrawal was filed on February 23, 2001, and a CPA was filed on February 23, 2001. The CPA filing fees were paid as a small entity.

In December of 1998, after the filing of the first provisional application, but before the filing of the second provisional application, UNOF entered into a license agreement (the 'in-license agreement') with a corporation (the "licensee corporation") under which UNOF licensed the instant application to the licensee corporation. The undersigned represents the licensee corporation and it is on behalf of the licensee corporation that the undersigned is prosecuting the instant patent application.

It has come to our knowledge that the licensee corporation has entered into a number of out-license agreements in the technology field relevant to the instant application, and below we summarize facts surrounding these license agreements that affect entity status.

First out-license agreement. Prior to entering into the in-license agreement with UNOF, the licensee corporation had entered a license agreement (the “first out-license agreement”) in this technology field in which the licensee corporation licensed technology to a corporation that did not at that time qualify for small entity status. Based on our review of this first out-license agreement, it appears that the instant application may have been licensed by the licensee corporation under the first out-license agreement and a corporation not qualifying for small entity status may therefore have had rights in the instant application at the time the application was filed on September 9, 1999 and at the time the CPA application was filed on February 23, 2001.

Second out-license agreement. After entering into the in-license agreement with UNOF but before the filing of the instant application on February 23, 2001, the licensee corporation amended a preexisting license agreement (the “amended second out-license agreement”) in this technology field, and under the amended second out-license agreement the licensee corporation licensed technology to a corporation that did not at that time qualify for small entity status. Based on our review of this amended second out-license agreement, it appears that the instant application may have been licensed by the licensee corporation under the amended second out-license agreement and a corporation not qualifying for small entity status may therefore have had rights in the instant application at the time the application was filed on September 9, 1999 and at the time the CPA application was filed on February 23, 2001.

Third out-license agreement. After entering into the in-license agreement with UNOF and after the filing of the instant application but prior to the filing of the February 23, 2001 CPA, the licensee corporation entered a license agreement (the “third out-license agreement”) in this technology field, and under the third out-license agreement the licensee corporation licensed

technology to a corporation that did not at that time qualify for small entity status. Based on our review of this third out-license agreement, it appears that the instant application may have been licensed by the licensee corporation under the amended third out-license agreement and a corporation not qualifying for small entity status may therefore have had rights in the instant application at the time the CPA application was filed on February 23, 2001.

Additional Out-License Agreements In addition to the three out-licenses described above the undersigned has identified at least two other out-licenses executed by the licensee corporation in this technology field prior to entering into the in-license agreement with UNOF.

The effect of these additional licenses on entity status appears however to be simply cumulative to the effects of the three out licenses describe above, and we have not included details of these licenses in this petition. If the office requires more information on these licenses, we will provide additional details.

Small Entity Claim in Instant Application

The instant application was filed on September 9, 1999 with a Verified Statement Claiming Small Entity Status, signed by a representative of UNOF and dated September 8, 1999.

This Verified Statement Claiming Small Entity Status had been provided to UNOF for signature by the law firm originally prosecuting the instant application. The law firm originally prosecuting the instant application is different from the undersigned law firm, which took over prosecution responsibility in about July 2002.

A CPA of the instant application was filed on February 23, 2001 by the law firm originally prosecuting the application and a representative of that law firm stated that the CPA application was entitled to small entity status and that a small entity statement had been submitted with the original application.

Small entity fees were paid in the instant application for all fees due from and including the filing of the application on September 9, 1999 through and including the filing of claim fees with a response to an office action filed on June 29, 2001. Subsequent to the June 29, 2001 payment, all fees were paid at the full amount without small entity discount.

Determination of Fees Due

To verify the entity status for payment of the issue fee due in the instant application, we investigated the assignment and licensing of this application and identified the facts set forth above. Based on these facts, we believe that at the time of filing of the original application on September 9, 1999 two or more corporations not qualifying for small entity status may have had license rights in the instant application. In addition we believe that at the time of filing of the CPA application on February 23, 2001 three or more corporations not qualifying for small entity status may have had license rights in the instant application. Based on these determinations we believe all small entity fees paid by the previous law firm in relation to this application should have been paid as large entity fees.

As required under 37 C.F.R. §1.28(c), to correct these oversights and in order for the error in payments to be excused we hereby submit an itemization of all erroneous small entity payments and the differential fees, together with the deficiency payment.

Itemization of all erroneous small entity payments and the differential fees:

TYPE OF FEE	DATE PAID	SMALL ENTITY FEE PAID	CURRENT FEE AMOUNT	LARGE ENTITY DIFFERENTIAL FEE
Application Filing Fee	September 9, 1999	\$ 512	\$ 770	\$ 258
Independent claims in excess of three	September 9, 1999	2 x \$39 = \$78	2 x \$86 = \$172	\$ 94
Claims in excess of twenty	September 9, 1999	6 x \$9 = \$54	6 x \$18 = \$108	\$ 54
Surcharge for Missing Parts of Application	October 7, 1999	\$ 65	\$ 130	\$ 65
Issue Fee	December 19, 2000	\$ 620	\$ 1330	\$ 710
CPA Filing Fee	February 23, 2001	\$ 449	\$ 770	\$ 321
Claims in excess of twenty	June 29, 2001	3 x \$9 = \$27	3 x \$18 = \$ 54	\$ 27
TOTALS		\$1,805 (Total Fees Previously Paid)	\$3334 (Current Fee Amount)	\$1529 (Corrected Fee Amount to be charged to Deposit Account No. 03-1952)

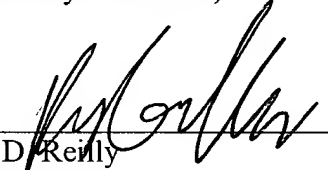
Based upon the above, Applicant believes the differential between the small entity fees previously paid and the large entity fees now owing should total \$1,529.00. Applicant requests this *differential fee* be paid from our **Deposit Account No. 03-1952.**

Pursuant to 37 C.F.R. § 1.28(c), the calculated deficient "large entity fees" are based upon the amount of the fee in effect at the time the deficiency is paid in full. In the event the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 515622000100.

Respectfully submitted,

Dated: February 9, 2004

By: _____


Philip D. Reilly
Registration No. 41,415

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5980
Facsimile: (650) 494-0792

Transaction List

Search by

Accounting Date

(MMDDYY)

Operator ID

Accounting Date

Find

Name/Number

09392869

Starts:

Ends:

Attny Docket No:

Deposit Account No:

Accounting
Date

Operator ID

Seq
NoTxn
SrcFee
Code

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Amount

Name/Number

Dep Acct

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02/26/2001	LGIBBS	8	SALE	231 ✓	A	355.00	09392869	061050
02/26/2001	LGIBBS	7	SALE	122	A	130.00	09392869	061050
12/26/2000	SDUONG1	136	SALE	561	A	30.00	09392869	
12/26/2000	SDUONG1	135	SALE	242 ✓	A	620.00	09392869	
04/07/2000	DCOATES	156	SALE	581	A	40.00	09392869	
10/14/1999	MMARMOL	55	SALE	205	A	65.00	09392869	
09/21/1999	DTHOMAS	50	SALE	203 ✓	A	54.00	09392869	
09/21/1999	DTHOMAS	49	SALE	202 ✓	A	78.00	09392869	
09/21/1999	DTHOMAS	48	SALE	201	A	380.00	09392869	



Adjustment Detail

Authorization Detail



Adjustment date: 02/13/2004 SLUANG1
 09/21/1999 DTHOMAS 00000030 09392869
 01 FC:201 -380.00 OP ✓
 02 FC:202 -78.00 OP 2
 03 FC:203 -54.00 OP 0

Done

Adjustment date: 02/13/2004 SLUANG1
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 02 FC:231 355.00 CR
 03 FC:202 40.00 CR 1
 04 FC:203 54.00 CR 0

Adjustment date: 02/13/2004 SLUANG1
 10/14/1999 MMARMOL 00000027 09392869
 01 FC:205 -65.00 OP

Done

Adjustment date: 02/13/2004 SLUANG1
 12/26/2000 SDUONG1 00000083 09392869
 01 FC:242 -620.00 OP

Done

Transaction List

Search by

☐ Accounting Date: (MMDDYY)

Operator ID:

Accounting Date

☒ Name/Number:

09392869

Starts:

Ends:

☐ Attny Docket No:

☐ Deposit Account No:



Accounting Date	Operator ID	Seq. No.	Txn Src	Fee Code	St	Amount	Name/Number	Dep Acct
09/18/2001	BNGUYEN2	112	SALE	142	A	1,240.00	09392869	
07/11/2001	RHARIS1	135	SALE	203	A	27.00	09392869	
02/26/2001	LGIBBS	10	SALE	203	A	54.00	09392869	
02/26/2001	LGIBBS	9	SALE	202	A	40.00	09392869	061050
02/26/2001	LGIBBS	8	SALE	231	A	355.00	09392869	061050
02/26/2001	LGIBBS	7	SALE	122	A	130.00	09392869	061050
12/26/2000	SDUONG1	136	SALE	561	A	30.00	09392869	061050
12/26/2000	SDUONG1	135	SALE	242	A	620.00	09392869	
04/07/2000	DCOATES	156	SALE	581	A	40.00	09392869	
10/14/1999	MMARMOL	55	SALE	205	A	65.00	09392869	
09/21/1999	DTHOMAS	50	SALE	203	A	54.00	09392869	



Adjustment Detail

Authorization Detail

